

U.S. Patent Application No. 10/655,694  
Attorney Docket No. 347269-991230

**STATUS OF THE APPLICATION**

- Claims 1-2, 5, and 7 are rejected under 35 U.S.C. § 112, first paragraph.
- Claims 1-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over combinations of U.S. Patent No. 5,902,677 to *Shi et al.* ("Shi"), Hirao et al., *J. Chem. Soc., Dalton Trans.*, 1996, p. 2929-2933 ("Hirao"), *Buretea et al.*, *Organometallics*, 1997, p. 1507-1510 ("Buretea"), and U.S. Patent No. 5,281,489 to *Mori et al.* ("Mori").

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### REMARKS

Please cancel claim 5.

#### The Rejection under 35 U.S.C. § 112, First Paragraph

Claims 1 and 2 have been amended to remove the recitation of a nonmetal. Claim 5 has been canceled. Accordingly, the rejection under 35 U.S.C. § 112, first paragraph is now moot.

#### The Rejection under 35 U.S.C. § 103(a)

Claims 1-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over combinations of *Shi*, *Hirao*, *Buretea*, and *Mori*.

Applicant respectfully traverses, on at least two grounds.

First, Applicant traverses on the ground that Examiner has not offered any motivation to combine *Shi* with any of the other references. To establish a prima facie case of obviousness, Examiner must offer some teaching, suggestion, or motivation to combine or modify the teachings of the prior art. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); MPEP 2143.01. Simply stating that it is "within the level of ordinary skill of a worker in the art" is insufficient. The worker cannot simply be able to make the suggested combination – he/she must also have a motivation to do so. *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986). As Examiner has offered no motivation to combine the cited references, no prima facie case of obviousness has been made, and the rejection cannot stand.

Second, Applicant traverses on the ground that none of these references discloses every element of Applicant's claims. More specifically, none of the references discloses a luminescence layer. In addition, none of the references discloses a luminescence layer having an electroconductivity of  $\sigma = 10^{-2} \text{ Scm}^{-1}$ .

#### *Shi*

As noted by Examiner, *Shi* does not disclose any of the compounds recited in Applicant's claims. *Shi* thus cannot disclose a luminescence layer made from such compounds. *Shi* also does not disclose a luminescence layer having an electroconductivity of  $\sigma = 10^{-2} \text{ Scm}^{-1}$ .

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### Hirao

*Hirao* discloses the testing of a number of compounds. However, the testing of *Hirao* concerns testing to determine the photoconductivity and electrical conductivity of these compounds (e.g., Abstract; p. 2932, column 2). *Hirao* never tests for the luminescence of these compounds. Accordingly, *Hirao* at most discloses conductive layers made from these compounds, i.e. layers that conduct electricity to varying degrees. *Hirao* does not disclose luminescent layers made from such compounds. In addition, *Hirao* does not disclose luminescence layers having an electroconductivity of  $\sigma = 10^{-2} \text{ Scm}^{-1}$ .

### Buretea

Like *Hirao*, *Buretea* discloses a number of compounds, but only discloses their electrical properties (e.g., p. 1509, col. 2). Accordingly, it at most discloses conductive layers, and not luminescent layers. *Buretea* makes passing mention of luminescence, noting merely that some compounds can exhibit electroluminescence, without any further explanation at all. However, such conclusory and unsupported remarks cannot support a rejection under 35 U.S.C. § 103(a). *In re Warner*, 154 USPQ 173, 178 (CCPA 1967). In addition, *Buretea* makes no mention of a luminescence layer having an electroconductivity of  $\sigma = 10^{-2} \text{ Scm}^{-1}$ .

### Mori

*Mori* is only discussed in the context of the rejection of claim 5, which is now canceled.

As above, none of *Shi*, *Hirao*, and *Buretea* discloses a luminescent layer, nor does it disclose a luminescent layer having an electroconductivity of  $\sigma = 10^{-2} \text{ Scm}^{-1}$ . Thus, claims 1-4 and 6-7 are patentable over these references for at least these reasons. For example, claims 1 and 2 recite a "polymer organic luminescence layer," while claims 3 and 4 recite an electroluminescence display having "an electroconductivity of  $\sigma = 10^{-2} \text{ Scm}^{-1}$  after oxidation . . . ." Claims 6-7 depend from any one of claims 1 to 4, and as such are patentable for at least these same reasons.

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### CONCLUSION

In view of the above, it is respectfully submitted that Claims 1-4 and 6-7 are now in condition for allowance.

The Examiner is invited to call Applicant's attorney at the number below in order to speed the prosecution of this application.

The Commissioner is authorized to charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 07-1896.

Respectfully submitted,

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